

**REMARKS**

**Foreign Priority:**

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and for confirming that the certified copy of the priority document has been received at the Patent Office.

**Information Disclosure Statement:**

Applicant thanks the Examiner for initialing and returning Form PTO/SB/08 A & B filed on October 20, 2003, thus indicating that all of the references listed thereon have been considered.

**Drawings:**

Applicant thanks the Examiner for indicating that the drawings filed with the present application have been approved.

**Allowable Subject Matter:**

Applicant thanks the Examiner for indicating that although claims 6, 12 and 18 have been rejected, these claims would be allowable if amended to address the Examiner's concerns under 35 U.S.C. § 112.

In view of Applicant's amendments (discussed more fully below), these claims have been placed in allowable condition.

**Claim Rejections:**

Claims 1-18 are all of the claims that have been examined in the present application, and currently all of the claims stand rejected.

***35 U.S.C. § 112, 2<sup>nd</sup> Paragraph Rejection - Claims 1-18:***

Claims 1-18 stand rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as being indefinite.

Specifically, the Examiner asserts that the claims are unclear and are narrative in nature.

In view of the Examiner's comments, Applicant has amended claims 1-18, as shown in the attached Appendix.

In view of the attached amendments, Applicant submits that the claims are clear to one of ordinary skill in the art. Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 112, 2<sup>nd</sup> paragraph rejection of these claims.

***35 U.S.C. § 102(b) Rejection - Claims 1 and 7:***

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,894,733 to Odaka. In view of the following discussion, Applicant respectfully traverses the above rejection.

As an initial matter, Applicant notes that the original limitations of claim 2 have been incorporated into claim 1. Therefore, claim 1 is now, simply, original claim 2 written in independent form. As such, the original scope of claim 2 has been maintained in claim 1.

Therefore, in light of the Examiner's admission that Odaka fails to disclose each and every limitation of original claim 2 (*see* Office Action dated February 23, 2005, page 3) Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(b) rejection of claims 1 and 7.

***35 U.S.C. § 103(a) Rejection - Claims 2-5 and 8-11:***

Claims 2-5 and 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Odaka in view of U.S. Patent No. 3,569,683 to Pugh. In view of the following discussion, Applicant respectfully traverses the above rejection.

Odaka discloses a tape winding machine, which winds magnetic tape from a starting reel 23 to a finishing reel 2 in the cartridge 5. During the transfer of the tape from one reel to the next, the portions of the tape which contain defects (which have been identified prior to loading the reel 23 into the device), are removed.

Odaka discloses using the combination of a tachoroller 24, which measures the tape speed, a scrapping means 26 and a changeover means 33, to remove the tape portions with defects, while maintaining the remaining portions of the tape.

As indicated above, the positions of the defects are noted prior to the tape transfer beginning. The defect positions are recorded in a setting means 34, and during the tape transfer the combination of the setting means 34 and tachoroller 24 allow the scrapping means 26 and changeover means 33 to effectively remove the defective portions of the tape. Specifically, by using the stored defect data and the tachoroller 24 to determine the position of the tape, the changeover means 33 directs the leading edge of the tape 6 to either the cutting means 26, where the defect portions will be cut out of the tape, or to the reel 2 in the cartridge 5.

The cut out portions of the tape are then directed to the reel 30, which holds the scrap tape portions.

However, in rejecting the above claims, including claim 2, the Examiner acknowledges that Odaka fails to disclose the claimed winding length deciding unit. To cure this deficiency,

the Examiner relies on Pugh, and alleges that Pugh sufficiently discloses this feature, and that it would have been obvious to combine Pugh with Odaka.

Applicant respectfully disagrees with both of the Examiner's assertions.

First, there is no disclosure in Pugh, which indicates, or suggests, that a winding length deciding unit makes any determinations regarding the presence or absence of a defect in a set winding length.

Specifically, in Pugh a user enters the position and distance of defects in a computer, which determines an optimum way and method of cutting the material (i.e. fabric), so as to satisfy the required cut-length requirements (i.e. based on inventory needs). However, to accomplish this, Pugh requires the operator to enter the position and length of each defect and the required cut lengths or styles to be cut.

Contrary to the present invention, there is no disclosure, or teaching, of the computer making a determination of the presence or absence of a defect in a set winding distance, as in Pugh the determination is made by the user.

Additionally, there is no disclosure or teaching of the computer determining a shorter winding length if a defect is detected in the first winding length. Stated differently, the Pugh device makes no determination or analysis of the presence of a defect in a set distance (for example 500 m) and then if a defect is detected, reducing the next winding length to a shorter length (i.e. 400 m) such that the defect is not included in the shorter winding length.

As indicated above, the positioning of the defects and the lengths to be cut are predetermined by a user, such that the Pugh computer does not determine a shorter winding length which would not include a defect.

It is for at least this reason, that the Examiner's argument fails. Even if the references were combined, the resultant combination would fail to teach or suggest each and every feature of the claimed invention.

Secondly, regardless of the Examiner's assertions, it would not have been obvious to a skilled artisan to combine the teachings of Odaka and Pugh, as suggested by the Examiner.

Namely, the Pugh device is directed to cutting a roll of material (i.e. fabric) into a number of short lengths (i.e. for drapes) in such a way as to optimize the number of usable pieces of material based on a requirement, such as inventory demand. However, Odaka is directed to the opposite result, where the desire is to produce a single magnetic tape having the maximum length possible. The goal of Odaka is not to achieve the maximum number of small pieces of magnetic tape, but to achieve a maximum single length of tape.

Because of at least these differences in the cited references, a skilled artisan would not have combined the references, as suggested by the Examiner.

Turning now to claim 5, Applicant disagrees with the Examiner's argument that the claimed ratio computing unit would have been obvious to a skilled artisan.

Specifically, even if the Examiner's statement is taken as true, it fails to capture the entirety of this claim limitation. Namely, the claimed ratio computing unit calculates a ratio based on the various winding lengths used, as opposed to a simple ratio of usable v. unusable tape.

Applicant submits that a ratio based on the used winding lengths (which can be, for example, 500 m, 400 m, 300 m, etc.) would be different from a ratio that simply looks at usable v. unusable tape. Because of this, the Examiner's allegation of obviousness goes too far.

In view of the foregoing, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine the above references as suggested by the Examiner. Further, even if one combined the references as suggested by the Examiner the resultant combination would fail to disclose, teach or suggest each and every feature of the claimed invention. Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claimed invention, as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of the claims.

***35 U.S.C. § 102(b) Rejection - Claims 1 and 13:***

Claims 1 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,317,951 to Karaki et al. In view of the following discussion, Applicant respectfully traverses the above rejection.

Again, Applicant notes that the limitations of original claim 2 have been incorporated into claim 1. Therefore, claim 1 is now, simply, original claim 2 written in independent form. As such, the original scope of original claim 2 has been maintained.

Therefore, in light of the Examiner's admission that Karaki fails to disclose each and every limitation of original claim 2 (*see* Office Action dated February 23, 2005, page 4) Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(b) rejection of claims 1 and 13.

***35 U.S.C. § 103(a) Rejection - Claims 2-5 and 14-17:***

Claims 2-5 and 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Karaki in view of the Pugh reference. In view of the following discussion, Applicant respectfully traverses the above rejection.

As an initial matter, Applicant notes that the Examiner is using the Pugh reference in the same fashion, and for the same purposes, as discussed previously with regard to the Odaka reference. Therefore, Applicant submits that the same arguments (set forth above) apply here.

Specifically, Pugh fails to teach or suggest the claimed winding length deciding unit, and it would not have been obvious to combine these references, for similar reasons to those discussed above.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine the above references as suggested by the Examiner. Further, even if one combined the references as suggested by the Examiner the resultant combination would fail to disclose, teach or suggest each and every feature of the claimed invention. Therefore, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the claimed invention, as required under 35 U.S.C. § 103(a). Accordingly, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of the claims.

**Conclusion:**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

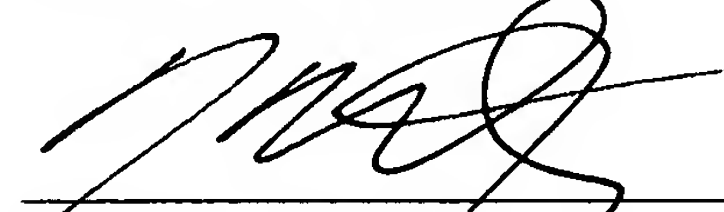
AMENDMENT UNDER 37 C.F.R. §1.111  
Application Number 10/687,609

Our Ref: Q77989  
Art Unit: 3654

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Terrance J. Wikberg  
Registration No. 47,177

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: May 20, 2005